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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|-----------------------|------------------|
| 10/612,363 | 07/02/2003 | Christopher J. Hess | 14834Z (ETH1540-CONT) | 5400 |
| 23389 | 7590 | 04/27/2005 | | |
| SCULLY SCOTT MURPHY & PRESSER, PC | | | EXAMINER | |
| 400 GARDEN CITY PLAZA | | | ROANE, AARON F | |
| SUITE 300 | | | | |
| GARDEN CITY, NY 11530 | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/612,363 | HESS ET AL. |
| | Examiner Aaron Roane | Art Unit 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 18-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shlain et al. (USPN 5,460,629).

Regarding claims 18 and 19, Shlain et al. disclose a surgical device comprising a shaft (12) having a proximal end and a distal end; a hook member (22) at the distal end of the shaft, the hook member configured to capture a vessel; and a sliding member (36) movable with respect to the hook member from a first position to a second position where the captured vessel is situated between the hook member and the sliding member; and at least one electrode (36) is provided with electrical energy delivery see col. 7, lines 13-33) for applying RF energy to cauterize the captured vessel, , see col. 2-9, especially col. 9, lines 36-46 and figures 21A and 21B. Additionally, it should be noted, in regards to claim 19, that the sliding member (36) is configured as “a movable forked paddle” (see response filed 11/24/2004, page 4, line 18) and since the siding member or movable

forked paddle is provided with electrical energy delivery, each tine of the forked configuration comprises an electrode at its distal end.

Claim 18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Knoepfler (USPN 5,397,333).

Regarding claim 21, Knoepfler discloses a surgical device comprising a shaft (13) having a proximal end and a distal end; a hook member (20) at the distal end of the shaft the hook member configured to capture a vessel; and a sliding member (34) movable with respect to the hook member from a first position to a second position where the captured vessel is situated between the hook member and the sliding member; and at least one electrode (20 is provided with unipolar electrical energy, see col.6, lines 5-18) for applying RF energy to cauterize the captured vessel, see col. 3-6 and figures 1-7.

Regarding claim 20, Knoepfler further discloses the hook member (20) is at least partially slidably disposed within the shaft, see col. 5-6 and figures 1-7.

Regarding claim 21, Knoepfler discloses a surgical device comprising a plunger (34); a hook member (20), the hook member and the plunger being movable relative to one another and configured to capture a vessel between the hook member and the plunger; and a cutting blade (23) slidably disposed within the plunger to sever the captured vessel, see col. 3-6 and figures 1-7.

Response to Arguments

Applicant's arguments filed 11/24/2004 have been fully considered but they are not persuasive. Beginning on page 5, line 2, Applicant asserts that Shlain "fails to teach or disclose at least a sliding member movable relative to a hook member between which a captured blood vessel is situated, as recited in claims 18-20 of Applicants' invention." The examiner disagrees. The claim merely recites that the sliding member is movable with respect to a hook member, which Shlain clearly discloses. Additionally, the recitation "between which a captured blood vessel is situated" is intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Next, on line 4, Applicant asserts "Shlain further fails to teach or disclose the at least one electrode for cauterizing a blood vessel captured between the plunger and the hook member." Again the examiner disagrees and points out that Shlain discloses the use of electrodes on the device for cauterizing tissue as evidenced by col. 3, line 30 through col. 4, line 10 and col. 5-9. As presented (in all broadness), Shlain meets the claimed inventions of claims 18 and 19.

Applicant next visits the Knoepfler reference and asserts that Knoepfler fails to disclose a plunger or a cutting blade slidably disposed within the plunger to sever a captured vessel. As presented above, Knoepfler discloses a plunger (34) movable with respect to a hook member (20) and a cutting blade (edge 23 on the distal end of 20) that is slidably disposed in the plunger. The recitation "to sever a captured vessel", where "sever" is interpreted as --sever--, is intended

use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here it should be noted that the use of “plunger” as opposed to “clamp” has not provided the examiner (and or Applicant) with reasons for removing Knoepfler as prior art that serves as rejecting art. The reason for this is that “plunger” as interpreted as broadly as possible does not preclude the interpretation of element (34) of Knoepfler as a plunger. Additionally, Applicant has provided no restrictive definition which further precludes the interpretation of element (34) of Knoepfler as a plunger.

Finally, Applicant has recited in both claims 18 and 21 that the sliding member (claim 18) or the plunger (claim 21) is/are moveable relative to a hook member (both claims 18 and 21). This is clearly evident in both Shlain and Knoepfler. The underline is added by the examiner to highlight a distinction between an element being moveable relative to a hook member or moveable relative to the shaft, which is a major distinction.

This Action is FINAL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*
April 20, 2005

michael peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER